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PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) SCS-550-471

	Application Number 10/714,483	Filed November 17, 2003
	First Named Inventor WATT	
	Art Unit 2183	Examiner C. Faherty

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the
☐ Applicant/Inventor

☐ Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

☒ Attorney or agent of record ___27,393___ (Reg. No.)

☐ Attorney or agent acting under 37CFR 1.34.
Registration number if acting under 37 C.F.R. § 1,34 _____

_____
Signature

Stanley C. Spooner
_____
Typed or printed name

703-816-4028
_____
Requester's telephone number

April 12, 2010
_____
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

☒ *Total of 1 form/s are submitted.

If you need assistance in completing the form, call 1-800-PTO-9199 and selection option 2.

STATEMENT OF ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following listing of clear errors in the Examiner's rejection and his failure to identify essential elements necessary for a *prima facie* basis of rejection is responsive to the Final Rejection mailed January 11, 2010 (Paper No. 20091119)

Error #1 The Examiner fails to support his §112(1st ¶) rejection

The Examiner has not previously alleged that the Appellant's specification does not support previous claims 3 and 22 which claims previously limited independent claims 1 and 20 from which they depended. These dependent claims defined "condition" as comprising "domain, mode **or** type of monitoring logic" (emphasis added). Since the alternative "or" is used, the transitory claim term "consisting," instead of "comprising," was deemed more appropriate in the October 29, 2009 amendment. The Examiner contends this is not supported in the specification.

There is no requirement to find *in haec verba* consistence between claim terms and terms used in the specification. Applicant, depending upon the scope of the prior art, is always entitled to limit a claim to less than all disclosed embodiments. In this case, the independent claims were limited to embodiments in which the condition is "domain, mode or type of monitoring logic." There is no statute, rule or MPEP section that requires that the specification contain a disclosure of the subset to which the claims are addressed. Moreover, a simple search of **all** patents issued by the PTO since 1976 with the phrase "consisting of" in at least one claim but missing from the specification, turned up 324,146 patents. Is the Examiner contending that all of these claims are invalid under 35 USC §112 (1st ¶) because there is no written description in the specification of these claim words? The Examiner points to no claim limitation that is not disclosed in the spec.

The Examiner simply does not support his rejection of the independent claims or claims dependent thereon under 35 USC §112 (1st ¶) and this is reversible error.

Error #2 The Examiner's definition of "control value relating to a condition" is inconsistent with the Board's Decision of March 31, 2009

While the Board agreed with the Examiner's broad claim term "control value" construction (prior to the current amendment), the Board did not agree with the Examiner's assertions as to what was disclosed in the cited prior art references. Specifically, the Board defined "condition" as being virtually anything taught by the prior art references (see Decision pages 7 and 8) and subsequently concluded that Angelo's (U.S. Patent 6,581,162) teaching of a "system request" met the unlimited but claimed "control value relating to a condition." (See the paragraph bridging pages 8 and 9 of the Decision). As the Board reiterated its broad construction of "control value" and the previously unlimited "condition" (Decision, first full paragraph on page 9), the Examiner apparently concludes that the "control value" and the more limited "condition" as set out in current claims 1 & 20 is still disclosed in the cited prior art.

Applicants have amended independent claims 1 and 20 to limit the definition to three embodiments disclosed in the specification and specifically state that "said condition consisting of a respective one of (a) a domain that said processor is operating in, or (b) a mode that said processor is operating in or (c) a type of said monitoring function . . . ." Applicants previously made of record page 762 from *Webster's Ninth New Collegiate Dictionary* which defines "mode," especially in conjunction with computers, as "a particular functioning arrangement or condition: STATUS <a spacecraft in reentry ~> <a computer operating in parallel ~>."

The Examiner is believed to be defining the term "mode" in a manner different from the ordinary dictionary definition of the word (which dictionary definition is consistent with the manner in which the term is used in Applicants' specification and claims). There is nothing in any definition of "mode" in the computer field that indicates that it can be a "control value" or some other active operating function in a computer. It is simply a designation of a particular

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"functioning arrangement or condition" of the computer. The Examiner is obligated to construe "mode" in the manner defined in the above dictionary definition, as used in the specification and in a manner well known to those of ordinary skill in the computer art, i.e., the attached definition of the term.

Error #3 The Examiner fails to meet his burden of coming forward with evidence that Alverson or Angelo teach any control value relating to a condition where that condition is (a) a domain, (b) a mode, or (c) a type of monitoring function – therefore no *prima facie* case of obviousness under 35 USC §103

Beginning on page 3, section 6 of the outstanding Final Rejection, the Examiner rejects claims 1, 2, 4-8, 11-18, 20, 21, 23-36, 38 and 39 under 35 USC §103 as unpatentable over Alverson in view of Angelo.

With the previously unlimited claim 1, the Board held that "one of the 'conditions' taught by Angelo is a system request" and "a system request, . . . , subsequently generates an interrupt (asserts the SMI) and enters the system into SM mode (FF 12)." Even applying the Board's analysis, the purported "control value" is the "SMI" of Angelo (as interpreted by the Board, Decision page 8 last full paragraph). The Angelo reference does not disclose a mode. In fact, in Angelo, the purported "control value" is an "interrupt" and an interrupt is clearly not a "mode" that the processor is operating in (nor does it meet the of record definition of "mode"). An "interrupt," by its nature, is a request to change the manner in which the processor is operating but is not an indication of the "mode."

Moreover, because Applicants have limited the independent claims' definition of "condition" to one of the three options specified in the independent claims, the Board's (and the Examiner's previous) extremely broad interpretation of "condition" can no longer apply. Thus, the Board cannot conclude that the term "condition" can be met by the Angelo "system request"

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because it is neither "(a) a respective one of a domain that said processing is operating in <u>or</u> (b) a mode that said processing is operating in <u>or</u> (c) a type of said monitoring function . . . ." In view of the more limited nature of the current claim definition of "condition," the Angelo reference and its "system request" does not meet the current claim limitations.

Absent a specific teaching of where the claim limitations are taught anywhere in the Alverson/Angelo combination, the Examiner fails to meet his burden of setting out a *prima facie* case of obviousness for independent claims 1 and 20 or claims dependent thereon.

Error #4 The Examiner's Final Rejection is vague and non-specific

It has been previously noted (in the amendment filed October 29, 2009, pages 13-14) that the Examiner previously cited large portions of the Angelo reference as purportedly teaching the claimed subject matter, but without identifying what portions he contends are the claimed subject matter. It is unclear as to whether the Examiner is maintaining his previous interpretation of this reference. The Board's construction of the "SMI" in Angelo and its definition of "condition" as being a "system request" is inconsistent with the Examiner's current interpretation of the Angelo reference. Accordingly, the Examiner's rejection is now believed to be completely unsupported by the Board of Patent Appeals and Interferences Decision and reconsideration is requested.

Error #5 The Examiner fails to provide the required "analysis" of reasons for combining the references and therefore fails to meet his obligation of evidencing a *prima facie* case of obviousness

In view of the more limited definition of "condition," the Examiner fails to provide the Supreme Court's required "analysis" as to his reasons for combining Alverson and Angelo in a manner that would disclose the claimed "condition." Even if the Examiner met his burden of showing where each and every claim limitation is shown in the Alverson/Angelo combination

(and, as noted above, his vague and indefinite references do not meet this burden of the first prong of a *prima facie* case), the Examiner fails to meet the second prong of the minimum requirements of a *prima facie* case of obviousness as imposed by the Supreme Court in the *KSR* decision. Accordingly, there is no *prima facie* case of obviousness.

Summary

The Examiner offers no legal support for his contention that the transitive claim term "consisting" must be disclosed *in haec verba* in Appellants specification or that an Appellant cannot limit his claims to a subset of preferred embodiments. The Examiner fails to adopt the Board's definition of a "control value relating to a condition" and clearly fails to demonstrate where the specifically claimed "condition" is disclosed in the combination of references. The Examiner's vague and indefinite references to Alverson and Angelo do not specifically identify where he contends the prior art discloses any of the three specifically claimed "conditions," i.e., (a) the "domain", (b) the "mode" or the "type of said monitoring function." Finally, the Examiner fails to provide the required "analysis" which would support his combination disclosures taken from the Alverson/Angelo combination.

As a result of the above, there is simply no support for the rejection of Applicants' independent claims 1 and 20 or claims dependent thereon under 35 USC §112 and/or §103. Applicants respectfully request that the Pre-Appeal Panel find that the application is allowed on the existing claims and prosecution on the merits should be closed.